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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,361	06/23/2003	Geert Defieuw	223303	7481

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EXAMINER

CHEA, THORL

ART UNIT PAPER NUMBER

1752

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/601,361	Applicant(s) DEFIEUW ET AL.	
	Examiner Thorl Chea	Art Unit 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 11-18 is/are allowed.
- 6) ☒ Claim(s) 1,2,4-10,19 and 20 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2, 4-10, 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Bauer et al (US Patent No. 5,422,234) and Sakai et al (US Patent No. 4,011,082).

Bauer et al discloses a thermally processable imaging element substantially as claimed. See the element in the abstract; the overcoat layer containing polyalkoxysilane in column 4, lines 49-68 to column 5; the coating aid in column 8, lines 5-10; and surfactant in column 13, line 40. Sakai et al discloses a surfactant within the scope of the claimed formula (I) when X is $-NR_2-$ and R2 is hydrogen atom, and R1 is an alkyl group. See Sakai et al in column 5, compound 24; and column 3, compound (III) when R' is an alkyl substituted heterocyclic group. It would have been obvious to the worker of ordinary skill in the art to use the surface active agent taught in Sakai et al to facilitate the coating process of the material taught in Bauer et al, and thereby provide a material as claimed.

3. Claims 11-18 are allowed.

Response to Arguments

4. Applicant's arguments filed May 31, 2005 have been fully considered but they are not persuasive. The applicants' argument is based on the ground that the rejection is improper due

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the combination of non-analogous arts. It was stated that the material of Bauer et al is directed to a photothermographic material and that of Sakai et al photographic art. There is no justification for selecting any surfactant from Sakai for use in Bauer system because the system of Bauer and Sakai are markedly distinct from one another, i.e. thermography vs. silver halide emulsion.

The argument is not persuasive. The main function of surfactant is to facility the coating process. The surfactant having $-\text{SO}_3$ group taught in Sakai et al is to facilitate the coating composition containing a binder such as hydrophilic colloid such as gelatin, colloidal albumin, casein. See column 7, lines 23-55. Bauer et al discloses the use of various colloid as binder for the thermally developable including hydrophilic colloid or hydrophobic colloid including gelatin, gelatin derivative and other synthetic polymeric compound (see column 7, lines 46-68). Therefore, it would have been obvious to the worker of ordinary skill in the art at the time the invention was made to select a surfactant taught in Sakai et al that is compatible with hydrophilic binder such as gelatin taught in Bauer et al with a reasonable expectation of improving the coating process of the thermally developable material, and thereby provide a material as claimed.

With respect to In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re*

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McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, the worker of ordinary skill in the art would have understood that the surfactant taught in Sakai et al would be compatible with a hydrophilic binder such as gelatin, and the use of such surfactant and the hydrophilic binder would have been found prima facie obvious to the worker of ordinary skill in the art at the time the invention was made.

The applicants argue that it is not uncommon for photographic antifoggant useful in conventional photographic material to cause various type of fog when incorporate into substantially light-insensitive thermographic or photothermographic material, or for supersensitizers that are effective in photographic material to be inactive in photothermographic material.

The argument is not persuasive. The properties presented in the argument may be true for the additive that affect the photographic property of the material such as antifoggant or supersensitizer, but there is no evidence showing that the surfactant useful in the in the photograohic material would not compatible with the surfactant for a thermographic or photothermographic material. The intend of using a surfactant is to improve the coating process rather than modify the photographic property of the material.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The US Patent No. 6,780,576 cited of interest is not considered as prior art due the same US filing date.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tch *th*
June 17, 2005

Thorl Chea
Thorl Chea
Primary Examiner
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